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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,764	03/25/2004	Thomas C. May	MIT-5038 USNP	5892
27777	7590	06/14/2007		
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			EXAMINER SHAFFER, RICHARD R	
			ART UNIT 3733	PAPER NUMBER
			MAIL DATE 06/14/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/808,764

Applicant(s)

MAY ET AL.

Examiner

Richard R. Shaffer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5 and 7-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5 and 7-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5 and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee et al (US Patent 5,480,403).

Lee et al disclose

[First Interpretation] a bioabsorbable copolymer of glycolide or lactide (**Column 4, Lines 22-29**) implantable cross-pin (**Figures 15-18**) comprising: an elongated member (**312**); a bullet-shaped nose member (**311**); an axial trough (**315**) in the elongated member extending from the proximal end (**314**) to a distal end (**316**) having an open top; an opening (**313**) at the distal end of the nose member (**311**) concentric with the longitudinal axis of the elongated member (**312**) and in communication with the trough (**315**). The opening (**313**) leads into a "tunnel" which can broadly be defined as a "passage" which extends axially into the axial trough (**315**). Applicant should structurally define the passageway such as "a passageway with an enclosed circular perimeter."

[Second Interpretation] a bioabsorbable copolymer of glycolide or lactide (**Column 4, Lines 22-29**) implantable cross-pin (**Figures 4-6**) comprising: an elongated member extending from the proximal end (**134**) to a distal end (half of the length of **Figure 5**); a bullet-shaped nose member (**131** and rest of **132**) extending out from the distal end of

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the elongated member; an axial trough (**135**) in the elongated member; a guide wire opening (and end of **133**) in the distal end of the nose member; and an interior tunnel (rest of **133**) extending axially (both the perpendicular axial direction as well as longitudinal axial direction along **135**).

Claims 1-3, 5 and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Hayhurst et al (US Patent 5,269,809).

Hayhurst et al disclose a bioabsorbable material of PLA or PLG (**Column 6, Lines 6-10**) implantable cross-pin (**Figures 1-5**) comprising: an elongate member (majority of length of **10** starting from the side with the axial trough (**18**); the axial trough (**18**) has an open top, a bottom (inner surface opposite open top); two opposed sides (**16**); a guide wire opening (**34**); an interior tunnel connecting the opening (**34**) to the axial trough (**18**); the guide wire opening (**34**) is concentric with the longitudinal axis of the device; and the nose member is bullet-shaped (broadest reasonable interpretation).

Response to Arguments

Applicant's arguments filed March 27th, 2007 have been fully considered but they are not persuasive. Applicant asserts that the new limitation of "tunnel" excludes the use of Lee et al. The American Heritage® Dictionary of the English Language, Fourth Edition defines tunnel to be a *passage through or under a barrier*. There is nothing in the broadest interpretation requiring an enclosed passageway. Therefore the previous rejection anticipated by Lee et al is deemed proper.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard R. Shaffer whose telephone number is 571-272-8683. The examiner can normally be reached on Monday-Friday (7am-5pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Richard Shaffer
June 10th, 2007



EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER